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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re Application of:

Nicolaides *et al.*

Serial No.: 09/853,646

Filing Date: May 14, 2001

For: A METHOD FOR GENERATING
HYPERMUTABLE ORGANISMS

Confirmation No.: 6480

Group Art Unit: 1632

Examiner: R. R. Shukla

Atty. Docket No. 001107.00138

RESPONSE TO REQUIREMENT FOR RESTRICTION

Assistant Commissioner for Patents
Washington D.C. 20231

Dear Sir:

This is in response to the Official Action dated December 10, 2002.

Applicants acknowledge the Requirement for Restriction and hereby traverse in part.

However, in order to be fully responsive to the Office Action, the Applicants provisionally elect Group I (Claims 1-7).

The Office Action requires restriction of four groups of claims. However, Applicants respectfully request reconsideration of the Requirement with respect to Groups I (claims 1-7) and III (claims 19-40).

Groups I and III are related, and thus are not independent inventions. However, the Office Action alleges that Groups I and III are distinct, as the claims of Group III require treatment with a mutagen, which is not required in Group I claims. According to the MPEP 808.02, the Examiner may insist upon restriction for related inventions, even if shown to be distinct, if one of three criteria may be shown: (1) there is a separate classification, (2) a separate status in the art, or (3) a different field of search is required. In the instant case, the claims of Groups I and III are classified in Class 435. A search of recently issued patents reveals that U.S.

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Patent Nos. 6,479,628; 6,007,993; 5,955,365; 5,888,498 and 5,776,502 are all classified in both U.S. Class 435/455 and 435/441. Firstly, although the *subclasses* are different in Groups I and III (435/455 and 435/441, respectively), the classification does not demonstrate an art-recognized, separate subject of inventive effort, and thus, the categorization as "separate classification" is not supported by recently issued patents. Secondly, the fact that patents have been issued bearing the same two U.S. sub-classifications together is evidence that the classification has not achieved a separate status in the art. Thirdly, it is not clear that a different field of search would be required to examine claims with the added element of treating the cells expressing a dominant negative allele of a mismatch repair gene with a mutagen. It is not evident that the Examiner would have to search in a field where no pertinent art to the other field exists.

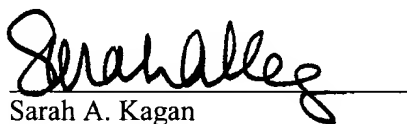
Finally, it is not an undue burden on the Office to examine the claims of Groups I and III in the same application. If Group III were elected and Group I was rejoined, this would entail the examination of only 7 additional claims. Applicants respectfully request withdrawal of the Requirement for Restriction and rejoinder of Groups I and III, which would be elected for prosecution. However, as stated at the outset, in order to be fully responsive to the Office Action, Applicants elect Group I (claims 1-7) for prosecution.

Applicants respectfully request that the examiner reconsider the Requirement for Restriction and rejoin Groups I and III, which would be elected for prosecution.

Respectfully Submitted,

January 9, 2003

By:



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